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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,387	03/10/2004	Eitaro Morita	8305-238US (NP148-1)	3592

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/797,387	MORITA, EITARO	
	Examiner	Art Unit	
	Ellen M. McAvoy	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/10/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 102(a) or (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andoh et al [European Patent Application (1,104,800)].

Andoh et al [“Andoh”] disclose a lubricating oil composition for internal combustion engines which comprises a major amount of base oil of lubricating viscosity and, as additives, a metal-containing detergent, a boron-containing alkenyl- or alkylsuccinimide, a zinc dialkyldithiophosphate, an oxidation inhibitor and an ashless dithiocarbamate. Andoh teaches that the lubricating oil composition has a boron content in an amount of 0.01 to 0.2 wt.%. See page 3, lines 5-27. Examples of suitable metal-containing detergents include metal salicylate and metal sulfonate, and the metal may be alkaline earth metals such as calcium, magnesium and barium. The detergents may be

neutral or overbased and having a total base number (TBN) of 150 to 300 mg KOH/g or higher. See page 3, lines 12-37. The ashless dithiocarbamate may be added to the composition in an amount of 0.1 to 5 wt.% and is set forth on page 5, lines 15-20. The examiner is of the position that the lubricating oil composition of Andoh clearly meets the limitations of the above rejected claims since the components may be the same and applicant's open-ended claim language "comprises" allows for the addition of other additives. Although an amount of sulfur of 0.01 to 0.3 % by mass (100-3000 ppm) in the lubricant composition is not set forth by Andoh, the examiner is of the position that the dithiocarbamate component may be added to the composition in an amount such that the sulfur content is within this claimed range.

Claim Rejections - 35 USC § 102/103

Claims 1-5 are rejected under 35 U.S.C. 102(a) or (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakamura et al [Japanese Patent (2000-034491)] and Saeki et al [Japanese Patent (2002-003875)], considered separately.

Nakamura et al ["Nakamura"] disclose a lubricating oil composition suitable for use in internal combustion engines comprising a major amount of two specific mineral oils, and, as additives, an organomolybdenum compound, a polybutenylsuccinimide-boron adduct, an alkaline earth metal sulfonate and an alkaline earth metal salicylate. Nakamura teaches that the amount of boron in the oil composition is within the range of 0.004-0.014 % by weight. Nakamura teaches that the sulfonate and salicylate detergents may be overbased having a TBN in the range of 310-500 mgKOH/g. Nakamura also

allows for the addition of an organic polysulfide compound in an amount of 50-1000 ppm of sulfur. The examiner is of the position that the lubricating oil composition of Nakamura clearly meets the limitations of the above rejected claims since the components may be the same and applicant's open-ended claim language "comprises" allows for the addition of other additives to the oil composition.

Saeki et al ["Saeki"] disclose gear oil compositions comprising a base oil and, as additives, (A) 2-10 mass % phosphorus-base and/or sulfur-base extreme pressure agent, (B) 100-500 mass ppm (in terms of boron) of a boric acid-modified succinimide, (C) 100-1000 mass ppm (in terms of an alkaline earth metal) detergent having a TBN of 100 mgKOH/g or higher, and (D) 150-1,500 mass ppm (in terms of zinc) of an alkyldithiophosphate. The examiner is of the position that the lubricating oil composition of Saeki clearly meets the limitations of the above rejected claims since the components may be the same and applicant's open-ended claim language "comprises" allows for the addition of other additives to the oil composition. Although an amount of sulfur of 0.01 to 0.3 % by mass (100-3000 ppm) in the lubricant composition is not set forth by Saeki, the examiner is of the position that the sulfur extreme pressure agent may be added to the composition in an amount such that the sulfur content is within this claimed range.

Claim Rejections - 35 USC § 103

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hata et al (6,303,546).

Hata et al ["Hata"] disclose a traction drive fluid which comprises a base oil blended with (A) an active phosphate ester base compound, (B) a boron-containing imide base dispersant, and (C) a boron-free imide base dispersant such that the boron content derived from component (B) is 100-600 ppm by weight, based on the base oil. Hata teaches that the oil composition may be used for a traction drive continuous variable transmission used in an automobile. Hata allows for the addition of other additives to the traction drive fluid including salicylate detergents, metal sulfonate rust preventive agents, sulfur-containing antiwear agents and metal deactivators of the benzotriazole and thiadiazole types. See column 7, lines 1-13. The examiner is of the position that the traction drive fluids of Hata clearly meet the limitations of the above rejected claims since the components may be the same and applicant's open-ended claim language "comprises" allows for the addition of other additives such as phosphorus ester component (A). Although an amount of sulfur of 0.01 to 0.3 % by mass (100-3000 ppm) in the lubricant composition is not set forth by Hata, the examiner is of the position that the sulfur-containing components may be added to the composition in conventional amounts such that the sulfur content is within this claimed range.

Conclusion

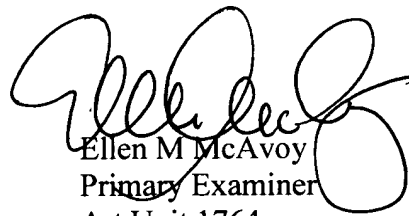
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 1764

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
August 29, 2006